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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,147	06/08/2000	Yasutaka Urakawa	030675-041	1209

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
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ALEXANDRIA, VA 22314

194664us6

EXAMINER

PERSINO, RAYMOND B

ART UNIT

PAPER NUMBER

2681

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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RECEIVED: 2/3/03  
OBLON, SPIVAK, MCCLELLAND  
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DOCKING DEPT.  
Initials/Date Docketed: 6/13 2/3/03  
Type of Resp(s): Response  
Due Date(s): 4-30-03

**Office Action Summary**

Application No.

09/589,147

Applicant(s)

URAKAWA, YASUTAKA

Examiner

Raymond B. Persino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Raith et al (US 6,073,005 A).

Regarding claim 1, Raith et al discloses a portable communication device for communication via a connected telephone circuit, comprising: emergency number memory means for storing an emergency telephone number and corresponding country information for each emergency call destination (column 5 lines 6-26); usable country information identifying means for identifying the country to whose telephone circuit the portable communication device is connected (column 5 lines 27-30); and calling

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processing means for automatically converting, as needed; an emergency telephone number input by a user into a corresponding emergency telephone number of the country wherein the portable communication device is connected, with reference to the emergency number memory means (column 5 lines 38-54).

Regarding claim 2, see the rejection of claim 1 concerning the subject matter this claim is dependant upon. Raith et al further discloses that the calling processing means dials an input emergency telephone number when the input emergency telephone number is stored in the emergency call memory means accompanied by country information coincident with usable country information identified by the usable country information identifying means (column 5 lines 28-35), and, when the input emergency telephone number is stored in the emergency call memory means and not accompanied by usable country information as identified by the usable country information identifying means, specifies, with reference to the emergency number memory means, an emergency telephone number coincident with the input emergency telephone number and which is stored in the emergency call memory accompanied by country information different from the usable country information, and then dials an emergency telephone number which corresponds to the specified emergency telephone number stored in the emergency call memory accompanied by the usable country information (column 5 lines 38-54).

Regarding claim 3, see the rejection of claim 1 concerning the subject matter this claim is dependant upon. Raith et al further discloses that the portable communication

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device is a portable telephone device (column 2 lines 32-33, column 3 lines 12-22 and column 3 line 65 to column 4 lines 12).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sanpei et al (US 5,732,329 A) discloses a device that is similar to the subject matter in the applicant's claims 1-3. (see column 5 lines 22-37, column 5 lines 45-60 and column 7 lines 9-23). However, Sanpei et al differs in that the teaching is limited to emergency calls being placed only via the actuation of a function key instead of the dialing of an emergency number. It is worth noting that column 4 lines 49-64 of Raith et al (see above) provides a teaching with motivation to modify the function key of Sanpei et al rendering the combination to be the same as that in the applicant's claims 1-3.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond B. Persino whose telephone number is (703) 308-7528. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (703) 305-4778. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9315 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Raymond B. Persino  
Examiner  
Art Unit 2681

RP  
January 23, 2003

  
RAYMOND PERSINO  
PATENT EXAMINER  
703-308-7528